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| 10/698,643      | 10/31/2003  | George P. Lahm       | BA9263 US DIV       | 5848             |

23906 7590 11/17/2004

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EXAMINER

DAVIS, ZINNA NORTHINGTON

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/698,643

Applicant(s)

LAHM ET AL.

Examiner

Zinna Northington Davis

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15,21-37,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-8,22,27-29 and 43 is/are rejected.
- 7) ☒ Claim(s) 9-16,21, 30-37 and 42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10/03.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-16, 21-37, 42 and 43 are pending. Claims 17-20 and 38-41 are cancelled.
2. In the response filed August 20, 2004, Applicants have elected Group II, drawn to compounds. The compound listed as page 66, in line 1 of Table 5 is the preferred species.

#### Response to the Restriction Requirement

3. Applicants traverse the restriction requirement on the basis that the parent of this application (now U.S. Patent 6,747,047) was not restricted to one of the following inventions: I: Claims 1-21, drawn to a composition and method for controlling arthropods using a compound of formula 1; II: Claims 22-43, drawn to a chemical compound. According Applicants respectfully request that the claims from both of these groups be included in this application. Additional searching should not be required if both groups are included. If restriction is maintained, Applicants elect Group II, claims 22-43 drawn to a chemical compounds.

It is the Examiner's position:

- Based upon Applicants remarks, the restriction requirement is withdrawn.
  - Groups II and I will be examined together based upon the single disclosed species.
  - The species includes J represents a 6-membered heteraromatic ring.
4. Claims 1-16, 21-37, 42 and 43 are Markush claims which are generic to the elected invention. The Markush type claim will be examined fully with respect to the elected

species and further to the extent necessary to determine patentability. See MPEP 803.02.

5. Claims 1-16, 21-37, 42 and 43 are objected on the grounds that the claims are drawn to an improper Markush group. In re Harnisch, 206 USPQ 300, states that a unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the claimed subject matter does not share a substantial structural feature disclosed as being essential to that utility. See Reference N, which teaches a similar class of compounds useful as fungicides.

The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural similarity in pharmaceutical agents is not in itself reason to render all the embodiments functionally equivalent.

6. The improper Markush groups are J, R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, and R<sup>4</sup>.

7. The examined subject matter includes a compound of formula I wherein J is a 6-membered heteroaromatic ring. Amending the claims to the examined subject matter would overcome the improper Markush objection.

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any

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new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1, 6-8, 22, 27-29 and 43 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-22 of prior U.S. Patent No. 6,767,047. This is a double patenting rejection.

The allowed subject matter has not been canceled from the instant claims.

10. Claims 9-16, 21, 30-37, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


11. The Information Disclosure Statement filed October 31, 2003 has been considered. The references alone or in combination form do not teach nor suggest structurally similar compounds as those instantly claimed. The closest prior art compounds have been excluded by proviso. Accordingly, no rejections based upon prior art are made.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna N. Davis whose telephone number is 571-272-0682.

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13. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications.

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number 571-272-1600.

  
**Zirma Northington Davis**  
**Primary Examiner**  
**Art Unit 1625**

Znd  
11.15.2004